In the Supreme Court of the United States

OCTOBER TERM, 1964

No. 871

KAROLINE CAUER, ET AL., PETITIONERS

v.

EDWARD J. BRENNER, COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

BRIEF FOR THE RESPONDENT IN OPPOSITION

OPINION BELOW

The opinion of the Court of Customs and Patent Appeals (Pet. A1–A5)[1] is reported at 332 F. 2d 831.

JURISDICTION

The judgment of the Court of Customs and Patent Appeals was entered on June 11, 1964. A timely petition for rehearing was denied on November 5, 1964. The petition for a writ of certiorari was filed on February 3, 1965. The jurisdiction of this Court is invoked under 28 U.S.C. 1256.

[1] "Pet. A" refers to the appendix to petitioners' petition; "Pet." refers to the petition; and "R" refers to the transcript of record filed in this Court.

QUESTIONS PRESENTED

1. Whether this Court has jurisdiction to review, on certiorari, decisions of the Court of Customs and Patent Appeals in patent cases.

2. Whether the Court of Customs and Patent Appeals refused to consider relevant legislative history in construing the statute involved in this case.

STATUTES INVOLVED

The Act of August 6, 1947, P.L. 380, 80th Cong., 1st Sess., 61 Stat. 794, 795, provides in part:

> SEC. 3. Nationals of Germany and Japan may hereafter apply for and obtain patents in the United States for their inventions in accordance with the patent laws and enjoy the rights and privileges thereof: * * * *And provided further,* That, except for patents based on applications filed in the United States Patent Office prior to the date of enactment of this Act, patents may not be applied for or obtained, or if obtained, shall not be valid, for any invention made, or upon which an application was filed by any such national, before January 1, 1946, in Germany or Japan or in the territory of any other of the Axis Powers or in any territory occupied by the Axis forces.

28 U.S.C. 1256 provides:

> *Court of Customs and Patent Appeals; certiorari*
>
> Cases in the Court of Customs and Patent Appeals may be reviewed by the Supreme Court by writ of certiorari.

* * * * *

35 U.S.C. 144 provides in part:

> The United States Court of Customs and Patent Appeals, on petition, shall hear and determine such appeal on the evidence produced before the Patent Office, and the decision shall be confined to the points set forth in the reasons of appeal. * * *

STATEMENT

Petitioners are the heirs of a German inventor, Dr. Wilhelm A. Cauer. On May 20, 1953, they filed an application for a patent based upon certain notes made by Dr. Cauer (R. 3–66). The patent examiner denied their application, holding that it was barred by Section 3 of Public Law 380, 80th Cong., 1st Sess. (R. 81, 84). That section provides, in pertinent part, that nationals of Germany and Japan may apply for patents, but that "patents may not be * * * obtained * * * for any invention made * * * by any such national, before January 1, 1946, in Germany or Japan * * *." On June 19, 1962, the Board of Appeals of the Patent Office affirmed the examiner's decision (R. 93–98). It held that in enacting Section 3, Congress intended to include in the term "invention made" writings or notes from which an invention was developed, such as those prepared by Dr. Cauer (R. 97–98).

Petitioners then appealed to the Court of Customs and Patent Appeals (R. 106). In connection with the preparation of the record on appeal, petitioners requested the Commissioner of Patents to furnish them with a certified copy of a certain Patent Office file on

Public Law 380 (Pet. A16–A17). This request was denied on the grounds that the decision of the Board of Appeals showed no reference to or reliance upon any paper in a Patent Office file; that the papers requested were not public documents; and that no other reason existed for certifying such file as part of the record of the application or as evidence produced before the Patent Office (Pet. A19). Thereafter, petitioners filed a motion with the Court of Customs and Patent Appeals seeking to compel the Commissioner of Patents to certify the file to the court (Pet. A9–A13). The court denied this motion, without opinion, on March 15, 1963 (Pet. A7). Petitioners then sought a writ of mandamus from this Court to compel either the Court of Customs and Patent Appeals or the Commissioner of Patents to submit the Patent Office file as part of the record on their appeal. This Court denied the petition. 375 U.S. 808.

On petitioners' appeal, the Court of Customs and Patent Appeals affirmed the decision of the Patent Office Board of Appeals on the ground that petitioners were "barred from obtaining a patent by the last provision of Section 3 of Public Law 380 * * *" (Pet. A1). The court reasoned that when Congress enacted Section 3 of Public Law 380 it intended to protect those members of the American public "who might act on those writings or inventive concepts collected from various repositories in Germany and Japan that were made available after the cessation of actual hostilities of World War II" (Pet. A5), and said that "[t]he term 'invention made' cannot be

given an interpretation inconsistent with that objective" (Pet. A5). It therefore construed the term "in the general and less technical sense" to include the notes made by Dr. Cauer.

ARGUMENT

1. Petitioners first assert that this Court should grant certiorari in order to settle the question whether it has jurisdiction to review a decision of the Court of Customs and Patent Appeals in a patent case (Pet. 9)—the issue which was left undecided by this Court in *Glidden Company* v. *Zdanok*, 370 U.S. 530, 578, n. 49. Petitioners correctly point out that it has been the government's view—so expressed in numerous briefs in opposition filed since *Glidden*—that the jurisdictional question is important and should be resolved by this Court. We have previously suggested, however, that its resolution should await a case presenting a patent question which is independently worthy of certiorari. Such a question is, in our view, presented by a recent decision of the Court of Customs and Patent Appeals holding that a patent may be obtained on a process for the production of a chemical compound, notwithstanding the applicant's inability to demonstrate any utility for the product, and we have filed a petition for a writ of certiorari in that case. *In the Matter of the Application of Andrew John Manson,* 333 F. 2d 234, No. 932, this Term. No purpose would be served by granting certiorari in the present case, however, since the underlying issue does not warrant review by this Court.

2. Petitioners also contend that in determining the applicability of Public Law 380 the Court of Customs and Patent Appeals erroneously refused to take judicial notice of items not in the printed record such as legislative history and published rulings of the Department of Justice (Pet. 9). In fact, however, the court's opinion makes plain that in construing what Congress meant by the phrase "invention made," the court looked to, and relied upon, several congressional committee reports on Public Law 380 which were not included in the printed record on appeal (Pet. A3–A5). Nor was it error for the court to refuse to consider the Patent Office file on Public Law 380 as legislative history of that statute, since the relevance of that file was highly questionable. Petitioners' contention that it would have demonstrated that the "patent experts of the Patent Office itself" chose the words "invention made" (Pet. 5) could not have significantly affected the result of this case. As the court observed: "We do not regard it as significant whether 'patent lawyers' * * * suggested that term * * *" (Pet. A4–A5). The court properly held that the controlling factor in this case was "what Congress intended by enacting Section 3 of Public Law 380 * * *" (Pet. A5), and not who suggested the statutory language. See *United States* v. *Wise,* 370 U.S. 405, 414; *United States* v. *Bryan,* 339 U.S. 323, 337–338.

3. Petitioners also argue, as they did in the court below (Pet. A5), that Dr. Cauer "was not considered a 'German national' by the Nazi regime; whereas

Public Law 380 was aimed at German nationals" (Pet. 8). Return Order 4333, dated January 24, 1963, on which petitioners rely (Pet. 8, n. 3), establishes no more than that the Alien Property Custodian returned to Dr. Cauer's heirs certain property which had been seized during World War II. The records of the Office of Alien Property reflect that the return order had been based upon Section 32(2)(D) of the Trading With the Enemy Act, 50 U.S.C. App. 32(2)(D), which permits the return of vested property to enemy aliens who suffered religious persecution as a consequence of the laws, decrees or regulations of the country of which he is a citizen. There is thus nothing in this record to indicate that Dr. Cauer was not a "German national" within the meaning of Public Law 380 prior to 1946. Indeed, the record contains a sworn statement by petitioners that Dr. Cauer was, prior to his death, a "citizen of Germany and a resident of Gross-Berlin, Germany" (R. 54).

CONCLUSION

For the foregoing reasons, it is respectfully submitted that the petition for a writ of certiorari should be denied.

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MARCH, 1965.

U.S. GOVERNMENT PRINTING OFFICE : 1965